

Application No.: 09/740,960
Reply to Office Action of June 10, 2004

REMARKS

The office action of June 10, 2004 has been carefully reviewed and these remarks are responsive thereto. Claims 2-29 remain in this application. Claims 11 and 18 have been amended. Claim 30 has been added. Reconsideration and allowance of the instant application are respectfully requested based upon the above amendments and the following arguments.

CLAIM REJECTIONS

Rejections Based on *Kanevsky* in view of *Linden*

Claims 2-5 and 18-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kanevsky et al.*, U.S. Pat. No. 6,496,949 (hereinafter referred to as *Kanevsky*) in view of *Linden et al.*, U.S. Pat. No. 6,549,773 (hereinafter *Linden*). Applicants respectfully traverse these rejections. Claim 2 recites:

A method for backing-up data in a wireless network, the method comprising steps of:

selecting data within a wireless device for backup in a storage area, the storage area being accessible by the wireless client device through the wireless network;

encrypting the selected data; and

sending the encrypted data to the storage area

wherein the step of sending the encrypted data to the storage area is done using a Wireless Application Protocol (WAP) technique.

The office action alleges that *Kanevsky* shows each limitation of the claim except for “the step of sending the encrypted data to the storage area ... using a Wireless Application Protocol (WAP) technique.” The office action correctly concedes that *Kanevsky* fails to disclose the use of a Wireless Application Protocol. Instead, the office action relies on *Linden*, alleging that it shows using a WAP application protocol for data transmission at column 7, lines 63-65. The office action further contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device disclosed by *Kanevsky* adapted to include sending the encrypted data to the storage area using a Wireless Application Protocol technique. The motivation that the office action provides for combining *Linden* and *Kanevsky* is that doing so “would allow for more efficient transmission of data in a wireless communications system.”

Applicants submit that the office action improperly combines these references. The

Application No.: 09/740,960

Reply to Office Action of June 10, 2004

Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should rigorously apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, not the applicant's disclosure. M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

Here, the stated motivation to combine the references ("more efficient transmission of data") is nothing more than a general statement that could apply to virtually any two references. Importantly, the office action points to nothing in Kanvesky or Linden that suggests the desirability of combining the use of WAP provided by Linden with the backup operations of Kanevsky. In order to establish a prima facie case of obviousness, more is needed. Accordingly, claim 2 is not properly rejected over the cited references. Claims 3-10 depend from claim 2 and are also allowable for substantially the same reasons, and further in view of additional reasons discussed below.

Claim 3 recites:

The method according to claim 2, wherein the step of sending the encrypted data to the storage area includes a step of encapsulating the encrypted data within a SyncML document.

The office action correctly concedes that neither Kanevsky nor Linden teach encapsulating encrypted data within a SyncML document. In order to cure this deficiency, the office action alleges that Kanevsky teaches encrypting data, while Linden teaches encapsulating coded data within a wireless markup language. According to the office action, it would have been obvious to one of ordinary skill in the art to include encapsulating the encrypted data within a SyncML document because it "would allow for improved security in data transmission between servers and communication devices connected to a wireless network."

Applicants respectfully submit that the stated motivation for combining Kanvesky and Linden is insufficient to establish a prima facie case of obviousness. The office action alleges that it would be obvious to one of skill in the art to encapsulate encrypted data within a SyncML

Application No.: 09/740,960

Reply to Office Action of June 10, 2004

document because doing so would allow for improved security in data transmission. However, as Kanevsky makes clear at column 3, lines 64-67, encrypting data allows sensitive data to be securely and effectively backed up:

The security labeling 126 allows sensitive or proprietary data to be identified and handled appropriately.

Plainly, Kanevsky provides by itself, the benefit alleged to be added by combining Linden. Thus, if security provided by encryption allows sensitive data to be “handled appropriately,” one of skill in the art would not look to Linden to receive a benefit already provided by Kanevsky. As a result, the proposed combination of Linden and Kanevsky lacks a motivation to combine, and a prima facie case of obviousness has not been established with respect to claim 3. In addition, there is no teaching of a SyncML document, nor is there any suggestion to modify these references to use a SyncML document. Thus, the cited references are completely devoid of any teaching of a SyncML document. Accordingly, claim 3 is not properly rejected over the cited references.

Claims 4 and 5 also stand rejected under the combination of Kanevsky and Linden, with the stated motivation to combine these references being identical to that provided with respect to claim 3. As discussed above, the office action improperly combines Kanevsky and Linden because there is no motivation or suggestion in the references to do so. Accordingly, claims 4 and 5 are not properly rejected over Kanevsky and Linden.

Claim 18 recites:

A wireless terminal device, comprising:
a memory capable of storing data;
a browser capable of allowing a user of the wireless terminal device to select data for backup storage;
a backup module capable of receiving the selected data upon its selection by the browser and encrypting the selected data; and
a backup application capable of sending the encrypted selected data to a storage area that is accessible to the wireless terminal device through a wireless network.

The office action alleges that Kanevsky teaches each claimed feature except for a browser, relying on Linden to cure this deficiency. Specifically, the office action alleges that Linden provides a browser that is used in a wireless communication device to control a user interface at column 2, lines 9-11. According to the office action, it would have been obvious to one of skill

Application No.: 09/740,960

Reply to Office Action of June 10, 2004

in the art at the time of invention to adapt Kanevsky to include a browser because it would allow for improved control of data transmission in a wireless communication system.

Applicants submit that claim 18 is not properly rejected for at least two reasons. First, there is no teaching or suggestion in either reference that provides a sufficient motivation to combine the references. The alleged motivation to combine references (improved control of data transmission) is not taught or suggested in the cited references. Linden does not suggest that the use of a browser would result in improved control of data transmission as alleged in the office action. Moreover, the alleged motivation is exceptionally vague, and amounts to nothing more than a conclusory statement that states a well-known fact.

In addition, the combination of Kanevsky with Linden, even if proper, fails to disclose the each feature recited in claim 18. Specifically, the combination fails to teach or suggest “a browser capable of allowing a user of the wireless terminal device to select data for backup storage” as recited in the claim. Kanevsky’s system is one which requires a system administrator or owner to pre-configure a backup scheme that activates only in the event of an emergency. For example, at column 2, lines 49-52 Kanevsky states that “[t]he type of backup done in an emergency is pre-selected by the system administrator or owner.” Clearly, the system in Kanevsky does not contemplate selection of data by a user of the device. Moreover, the combination also fails to teach or otherwise suggest the claimed feature of “a backup module capable of receiving the selected data upon its selection by the browser and encrypting the selected data” as recited in claim 18. Instead, Kanevsky provides that data is pre-selected and encryption of data occurs only after an emergency sensor detects an emergency, not “upon its selection by the browser.” Accordingly, claim 18 is not properly rejected over the cited references. Claims 19-29 depend from claim 18 and are allowable for substantially the same reasons, and further in view of additional reasons provided below.

Claim 21 recites:

The wireless terminal device according to claim 18, wherein the encrypted selected data is encapsulated within a SyncML document.

As discussed previously in connection with claim 3, there is no teaching of a SyncML document in the cited references, nor is there any suggestion to modify them to use a SyncML document. As a result, the cited references are completely devoid of any teaching of a SyncML document.

Application No.: 09/740,960
Reply to Office Action of June 10, 2004

Rejections Based on *Kanevsky* in view of *Linden* and further in view of *Langford*

The office action rejected claims 6-17 and 24-29 under 35 U.S.C. § 103(a) as unpatentable over *Kanevsky* in view of *Linden* and further in view of *Langford*, U.S. Pat. No. 6,574,733 ("*Langford*"). Applicants respectfully traverse these rejections. As noted previously, claims 6-10 depend from claim 2, and are allowable as being dependent on an allowable base claim. Similarly, claims 24-29 depend from claim 18, and are allowable as being dependent on an allowable base claim.

Claim 11 recites:

A method for accessing backed-up data in a wireless network from a wireless device, the method comprising steps of:

downloading the backed-up data from a storage area, the backed up data having been previously selected for backup by a user of the wireless device, the backed-up data further containing encrypted data encrypted by an encryption module upon the selection of the data, and the storage area being accessible by the wireless device through the wireless network; and

decrypting the downloaded backed-up data.

As discussed previously in connection with claim 18, neither *Kanevsky* nor *Linden* show "data selected data by a user of the wireless device," but only disclose a system that requires a system administrator to configure the backup routine. *Langford* does not cure this deficiency. Moreover, none of the cited references, alone or in combination, teach or suggest "encrypted data encrypted by an encryption module upon the selection of the data" as recited in claim 11. Rather, the encrypting step in *Kanevsky* takes place only after an emergency event is detected. In view of these differences, claim 11 is allowable. Claims 12-17 depend from claim 11, and are also allowable for substantially similar reasons, and further in view of additional reasons provided below.

Claim 15 recites:

The method according to claim 11, wherein the backed-up data is embedded in a SyncML document.

As discussed previously in connection with claims 3 and 21, neither *Kanevsky* nor *Linden* teach or suggest the use of a "SyncML document" as recited in the claim. *Langford* does not cure this deficiency. Thus, for this additional reason, claim 15 is allowable over the cited references.

Application No.: 09/740,960
Reply to Office Action of June 10, 2004

Conclusion

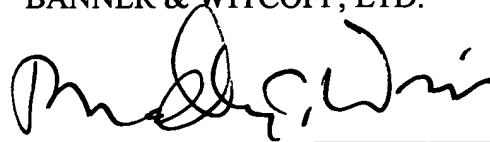
It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733 accordingly.

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: 09/17/2004

By:



Bradley C. Wright
Reg. No. 38,061

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001